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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,696	01/19/2001	Daniel S. Sem	P-TB 4567	6467

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EXAMINER

BAKER, MAURIE GARCIA

ART UNIT PAPER NUMBER

1627

DATE MAILED: 09/03/2002

19

Please find below and/or attached an Office communication concerning this application or proceeding.

# Advisory Action

Application No.

09/765,696

Applicant(s)

Sem

Examiner

Mauri G. Baker, Ph.D.

Art Unit

1627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Aug 12, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

## THE PERIOD FOR REPLY [check only a) or b)]

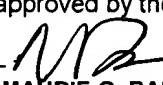
- a) ☒ The period for reply expires THREE months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: Please see attached.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_
- Claim(s) objected to: \_\_\_\_\_
- Claim(s) rejected: 9, 11-14, and 37
- Claim(s) withdrawn from consideration: 1-8
8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

  
MAURIE G. BAKER, PH.D.  
PATENT EXAMINER  
ART UNIT 1627

**ADVISORY ACTION**  
*Attachment*

1. Applicant's After Final amendment filed August 12, 2002 raises considerable new issues which would require further search and/or consideration and does not place the case in better form for appeal or in condition for allowance. Thus the amendment will not be entered.

2. It is noted for the record that the proposed amendments to claims 9, 11, 12, 13, 14 and 37 would obviate the *previous* rejections under 35 U.S.C. 112, first paragraph, if the amendments were entered in further prosecution of the instant case. However, the proposed amendments to these claims *raise new issues*, such as with the term "mimic" (under 35 U.S.C. 112, second paragraph and/or 35 U.S.C. 112, first paragraph).

3. Applicant's arguments are moot in view of the non-entry of the amendment; however, certain portions thereof are addressed below in the interest of clarity and compact prosecution. Due to the non-entry of the amendment, all previous rejections are maintained for reasons of record.

4. In the After Final amendment Applicant proposes to add *eleven new claims* (five independent) and cancels no finally rejected claims. This is improper and the proposed new claims raise considerable new issues as described below.

5. Applicant states in the arguments (on page 10, bottom and elsewhere) with respect to the newly added claims, that the claims

“recite substantially the same language as amended claim 9 but are directed to a dehydrogenase enzyme family (claims 38-40), an enzyme family that binds nicotinamide adenine dinucleotide (claims 41-43) and an enzyme family that binds nicotinamide adenine dinucleotide phosphate (claims 44-46). Accordingly, in view of the remarks above and Examiner Baker’s indication that such language would likely overcome rejections under 35 U.S.C. § 112, Applicant respectfully submits that the specification provides sufficient description and guidance for new claims 38-46. Similarly, Applicant respectfully submits that the specification provides sufficient description and guidance for new claims 47 and 48.”

6. The examiner would like to state for the record that the examiner only considered proposed amendments to claims previously under consideration (i.e. claim 9) filed via fax at the interview of July 23, 2002. The proposed new claims (i.e. proposed claims 38-48) were not specifically considered at that time.

7. Furthermore, the new claims are not drawn to the elected species, as applicant asserts (on page 15, 2<sup>nd</sup> paragraph). The species election was two-fold and Applicant elected dehydrogenase AND nicotinamide adenine dinucleotide. None of the newly proposed claims are drawn to both of these species, but instead are drawn to one or the other. Furthermore, there are proposed new claims that are drawn to *non-elected species* (nicotinamide adenine dinucleotide phosphate). For all of these reasons, the proposed new claims raise a variety of new issues which would require further search and consideration.

8. Note the following from MPEP § 803.02, which was recited in the first Office Action on the merits with respect to species election and is reiterated here, with special emphasis on After Final prosecution:

On the other hand, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a nonelected species, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all nonelected species. Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection, as by amending the Markush-type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush-type claim will be reexamined. The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim. In the event prior art is found during the reexamination that anticipates or renders obvious the amended Markush-type claim, the claim will be rejected and the action made final. Amendments submitted after the final rejection further restricting the scope of the claim may be denied entry.

9. There were no claims specifically directed at the instantly elected species filed in previous prosecution. As stated above, no claims specifically directed at the instantly elected species have been filed in the instant After Final amendment either. *There is no allowable generic claim.* Also, the broad claims (i.e. 9, 11, 12, 13, 14 and 37) have not been cancelled.

10. Moreover, proposed new claims 47 and 48 appear to be drawn to different inventions than the one currently under examination with respect to common ligands that compete for cofactor binding (proposed independent claim 47) and enzyme families that comprise two or more enzymes that bind to the same cofactor (proposed independent claim 48).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie Garcia Baker, Ph.D. whose telephone number is (703) 308-0065. The examiner can normally be reached on Monday-Thursday from 9:00 to 6:30 and alternate Fridays.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane, can be reached on (703) 308-4537. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Maurie Garcia Baker, Ph.D.  
August 29, 2002

A handwritten signature in black ink, consisting of stylized initials 'MB' followed by a long horizontal line extending to the right.

**MAURIE GARCIA BAKER, Ph.D.  
PATENT EXAMINER**